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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,246	06/27/2000	Toru Ebihara	500.38711X00	5041

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ARLINGTON, VA 22209

EXAMINER

HAQ, NAEEM U

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/604,246

Applicant(s)

EBIHARA ET AL.

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Response to Amendment***

This Office Action is in response to the Applicants' amendment, paper number 5, filed on November 26, 2002. Claims 1-9 are pending and will be considered for examination.

### ***Specification***

The abstract of the disclosure is objected to because it exceeds 150 words. Correction is required. See MPEP § 608.01(b).

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. In particular, the Applicants' have listed references JP-A-9-288696, JP-A-10-224549, and JP-A-10-214284 on page 1 of the specification without filing an Information Disclosure Statement. Therefore these references have not been considered.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims recite the conditional statement "when". It is unclear to the examiner what the scope of the claim is when the conditional statement is false.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada (US Patent 6,336,100 B1) in view of DeLorme et al (US Patent 5,948,040).**

Referring to claims 1-9, Yamada teaches a system and method of ordering and delivering merchandise in an electronic mall, comprising:

- opening an electronic mall composed of virtual stores on a network (column 2, lines 18-24, lines 34-38);
- accepting access from a user terminal available to any user to said electronic mall through a communication path (column 2, lines 12-17, lines 25-33; Figure 1, items "1" and "3");

- providing merchandise information to said user terminal (column 4, lines 41-48; Figure 8);
- accepting an order of merchandise from the user on the basis of said merchandise information (column 4, lines 49-7; column 5, lines 1-12);
- providing delivery destination selection information concerning delivery of said ordered merchandise to said user terminal (column 1, lines 18-21; column 4, lines 27-67; Figures 4, 5, and 6);
- accepting a delivery destination requested from said user terminal on the basis of said delivery destination selection information (column 2, lines 66-67; column 3, lines 1-18; column 4, lines 49-56; Figure 9);
- accepting a specific delivery destination determined from said user terminal base on information (column 4, lines 49-67; column 5, lines 1-12);
- providing information of said specific delivery designation and said merchandise order information to said determined delivery destination (column 3, lines 66-67; column 4, lines 1-3).

Yamada does not teach that the communication path is a public telephone line. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to implement the system and method Yamada using a public telephone line. One of ordinary skill in the art would have been motivated to do so in order to use a well-known and readily available communication medium to implement the invention of Yamada. Yamada also does not teach providing map information indicating candidates of available merchandise relay station or accepting the specific

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delivery destination based on the map information. However, DeLorme teaches a system and method of planning an activity using digital maps (Figures 1B-1 and 1B-3). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of DeLorme into the system and method of Yamada. One of ordinary skill in the art would have been motivated to do so in order to allow an individual to plan review, locate, schedule and select or execute customized or personalized travel arrangements and activities in association with map displays as taught by Delorme (column 1, lines 37-65).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

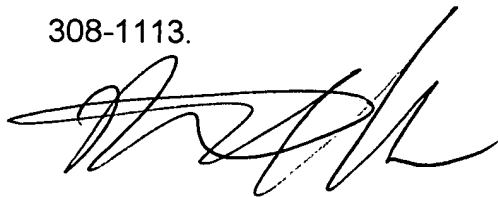
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703)-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-305-7687 for regular communications and (703)-305-7687 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1113.



Naeem Haq, Patent Examiner  
Art Unit 3625

February 5, 2003



WYNN W. COGGINS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600